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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/489,143
Filing Date: January 21, 2000
Appellant(s): BAER ET AL.

Stuart B. Shapiro
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/22/10 appealing from the Office action mailed

04/01/10.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Ex Parte William J. Baer et al., U.S. Patent Application Serial No. 09/488,971, U.S. Patent No. 7,346,844, Appeal No. 2006-1674.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1 - 24 are currently rejected under 35 U.S.C. §103(a) and are on appeal.

Claims 25 - 27 have been canceled.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in

the brief.

The examiner has no comment on the appellant's statement of the grounds of rejection to

be reviewed on appeal. Every ground of rejection set forth in the Office action from which the

appeal is taken (as modified by any advisory actions) is being maintained by the examiner except

for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW

GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the

Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,147,768	NORRIS	11-2000
6,072,479	OGAWA	06-2000
5,768,521	DEDRICK	06-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 1-2, 7-8, 9-10, 15-18, 23 and 24, are rejected under 35 U.S.C. 103(a) as being unpatentable over Norris (US-6,147,768 11/14/00) in view of Ogawa (US-6,072,479 06/06/00).

-In regard to substantially similar independent claims 1, 9, and 17, Norris teaches a computer-implemented method, medium, and system for determining the cost of and producing a user-defined content object comprising:

defining said content object ("photographic album") in accordance with user selection and arrangement (Fig. 3: "mats") of a plurality of content entities ("photographic image") for said content object ("photographic album")(column 4, lines 53-67; column 5, lines 1-24; column 7, lines 49-67; column 8, lines 1-67; column 9, lines 1-13)(Figs. 2 & 3), wherein the content object is a digital object within the computer in the form of one of a book, a collection of images, an album, a video and a multimedia object (i.e. the photographic album is a collection of images), and the content entities each include content comprising digital data ("video images" & "size of the selected image"), are stored within a data repository as a plurality of individually accessible file objects (column 7, lines 65-67; column 8, lines 1-24)(Fig. 2), and are selectively associated with an actual content count representing the quantity of content within that content entity (column 7, lines 65-67; column 8, lines 1-40: "number of each size print is counted"); and

generating a price for the user to produce the user-defined content object, wherein said

price is one of an actual price based on a parameter setting (column 5, lines 16-22: "price

database...prices for various sized pictures and various mats"; column 6, lines 12-22: "calculate a

customer invoice...picture sizes selected...their selected page locations"; column 8, lines 35-40:

"the number of each size print is counted and then multiplied out by the price per unit"; column

9, lines 10-14; column 10, lines 4-17: "price is generally determined by the number and size of

the selected images"), wherein the quantity of content of content within the content object could

be determined via the digital data within the selected content entities (column 6, lines 12-22:

"calculate a customer invoice...picture sizes selected...their selected page locations"; column 8,

lines 35-40: "the number of each size print is counted and then multiplied out by the price per

unit"; column 9, lines 10-14; column 10, lines 4-17: "price is generally determined by the

number and size of the selected images") and said price generation includes and generating the

actual price to serve as the price for the user to produce the user- defined content object from the

actual content counts of the selected content entities in response to said parameter setting

indicating the actual price (column 5, lines 16-22: "price database...prices for various sized

pictures and various mats"; column 6, lines 12-22: "calculate a customer invoice...picture sizes

selected...their selected page locations"; column 8, lines 35-40: "the number of each size print is

counted and then multiplied out by the price per unit"; column 9, lines 10-14; column 10, lines 4-

17: "price is generally determined by the number and size of the selected images").

Norris teaches wherein printing photographic albums can be costly and a general

motivation for decreasing the expense of printing electronic photo albums (column 1, lines 37-

54: "costly...adding expense to the project...eliminating the cost"). Norris does not specifically

teach generating an estimated content count for the selected content entities that represents an

estimated quantity of content within the content object, wherein the digital data within the

selected content entities are utilized to determine the estimated content count representing the

estimated quantity of content within the content object, and generating from the estimated

content count the estimated price to serve as the price for the user to produce the user defined

content object with the selected content entities in response to said parameter setting indicating

the estimated price, wherein the estimated price is determined based on a price per unit of

content, and wherein the unit of content represents a predetermined quantity of content and the

estimated content count indicates an estimated quantity of said units of content for the selected

content entities. Ogawa teaches generating an estimated content count for the selected content

entities that represents an estimated quantity of content within the content object, wherein the

digital data within the selected content entities are utilized to determine the estimated content

count representing the estimated quantity of content within the content object, and generating

from the estimated content count the estimated price to serve as the price for the user to produce

the user defined content object with the selected content entities in response to said parameter

setting indicating the estimated price, wherein the estimated price is determined based on a price

per unit of content, and wherein the unit of content represents a predetermined quantity of

content and the estimated content count indicates an estimated quantity of said units of content

for the selected content entities (column 1, lines 13-15: "creating multimedia applications";

column 2, lines 41-54: "estimate the size of the data...cost"; column 3, lines 20-46: "media

objects or inputting existing media objects....media dependent attribute of an actual media

object...calculation module calculating sizes of the actual media data...to estimate the total size

of an overall application...adds up actual media creation costs for calculation of an estimate of

the cost of each media type and an overall application"; column 4, lines 6-46: "surrogate media

objects representing actual media objects including moving picture objects, voice objects, and/or

images...user to enter media-dependent attributes...estimating the size...estimating total cost";

column 5, lines 29-35; column 11, line 45-column 12, line 63: "reads media attribute

information...calculates the data size of each object...may be used as a transfer data amount

estimate...one scene at a time...user to estimate costs"; column 13, line 45-column 14, lines 37:

"calculate the costs only for user-selected media types...allow the user to enter a cost...displays

the cost calculated")(Figs. 11 & 12). It would have been obvious to one of ordinary skill in the

art the time of the invention for the system of Norris to have included the estimated content

count/cost feature of Ogawa, because Ogawa taught that by determining an estimated content

size/count and subsequent estimated cost/price of a specific content entity the user would be

provided the benefit of making an informed decision about the cost/size of said entity (column 2,

lines 41-67: "important to estimate the size of data...poor application quality...lower

development costs...keep track of progress").

        -In regard to substantially similar independent claims 2, 10, and 18, Norris teaches

wherein the step of generating an estimated content count further comprises the steps of

determining an estimated content count for each selected content entity, and summing the entity

content counts to obtain the estimated content count for the content object (column 8, lines 35-

40: "the number of each size print is counted and then multiplied out by the price per unit";

column 9, lines 10-14; column 10, lines 4-17: "price is generally determined by the number and

size of the selected images"). Additionally, for similar benefits as disclosed above, Ogawa also

teaches determining an estimated content count for each selected content entity and summing the

entity content counts to obtain the estimated content count for the content object (Fig. 11: 114,

115, 117, 1110, 1111, 1112).

-In regard to substantially similar independent claims 7, 15, and 23, Norris teaches

wherein the content object further comprises user-provided content, and wherein generating a

price for the content object further comprises the steps of separately determining a price for user-

provided content and generating the selected estimated or actual price by summing the user-

provided content price with the price determined for the remaining selected content entities of

the content object (column 3, lines 25-58: "capturing video images to be entered into a

database"; column 5, lines 22-45; column 5, lines 16-22: "price database...prices for various

sized pictures and various mats"; column 6, lines 12-22: "calculate a customer invoice…picture

sizes selected…their selected page locations"; column 8, lines 1-40: "notes associated with the

displayed photographs can be added…the number of each size print is counted and then

multiplied out by the price per unit"; column 9, lines 10-14; column 10, lines 4-17: "price is

generally determined by the number and size of the selected images").

-In regard to substantially similar independent claims 8, 16, and 24, Norris teaches

wherein the price for user-provided content is determined in a first manner if the content count of

the user- provided content exceeds a predefined content count maximum, and is determined in a

second manner if the content count does not exceed the predefined maximum (column 4, lines

64-67; column 5, lines 1-22: "price database...prices for various sized pictures and various mats";

column 6, lines 12-22: "calculate a customer invoice...picture sizes selected...their selected page

locations" & 63-67: "automatically sizes each image to accommodate all sizes which are

necessary for use with a particular mat manufacture selected"; column 8, lines 1-40: "notes

associated with the displayed photographs can be added...the number of each size print is

counted and then multiplied out by the price per unit"; column 9, lines 10-14; column 10, lines 4-

17: "price is generally determined by the number and size of the selected images")(Fig. 3).

Claims 3-6, 11-14, and 19-22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Norris (US-6,147,768 11/14/00) in view of Ogawa (US-6,072,479

06/06/00) in further view of Dedrick (US-5,768,521 6/16/98).

-In regard to substantially similar independent claims 3, 11, and 19, Norris teaches

wherein the selected content entities could contain text characters (column 8, lines 1-24:

"notes"). Norris does not specifically teach determining an estimated content count for entities

containing characters comprises the step of determining a character count for the entity. Dedrick

teaches a method of metering the flow of electronic information to a client computer (Abstract).

Dedrick teaches determining a unit of information count for the content entity (a digital

entry)(column 1, line 62 – column 2 line 22; column 3 lines 60-63; column 4 line 26 – column 5

line 25; and column 7 lines 29-43). Dedrick specifically teaches estimating a content count for

each content entity may be calculated in bytes or words in (column 4, lines 63-64; column 5,

lines 10-25). It would have been obvious to one of ordinary skill in the art at the time of the

invention to applying the per byte/word character count of Dedrick to the calculation and

counting system of Norris, because Norris would have been provided the benefit of applying

metering to virtual objects such as online books, digital directories etc (column 4, lines 65-67:

"desirable when the end user is accessing a database that contains…drawings and text"; column

5, lines 1-2).

                -In regard to substantially similar independent claims 4, 12, and 20, Norris teaches

wherein the step of determining an estimated content count further comprises the step of

determining a page count from the character count (column 8, lines 1-53: "Pages 116…all

changes are reflected in the next invoice generated"). Additionally, for similar benefits as

disclosed above, Dedrick teaches specific examples that the content count unit may be in bytes or

words in (column 4, lines 63-64; column 5, lines 10-25). Determining a page count from the

character count is merely changing the units of the count from characters to pages. Dedrick

teaches an information unit count of bytes in column 4, lines 63-64 and megabytes in column 5,

lines 21-23. The two example units of Dedrick are related exactly as the characters and pages of

the claimed invention. Therefore, it would have been obvious to one of ordinary skill in the art at

the time the invention was made to have applied Dedrick to Norris, providing Norris the benefit

of converting characters/images into pages so that the cost computation would have been

simplified.

                -In regard to substantially similar independent claims 5, 13, and 21, Norris does not

specifically teach wherein the step of determining a character count further comprises at least

one of: counting the number of content characters in the content entity and determining the

content entity type, and determining an average character count for content entities of that type.

Dedrick teaches determining a unit of information count for a content entity based on counting

the number of content characters in the content entity (column 4, lines 63-64; column 5, lines 10-

25). It would have been obvious to one of ordinary skill in the art at the time of the invention to

counting the number of the per byte/word character count of Dedrick to the calculation and

counting system of Norris, because Norris would have been provided the benefit of applying

metering to virtual objects such as online books, digital directories etc (column 4, lines 65-67:

"desirable when the end user is accessing a database that contains…drawings and text"; column

5, lines 1-2).

-In regard to substantially similar independent claims 6, 14, and 22, Norris teaches

wherein the step of generating a content object price further comprises multiplying the page

count with a predetermined price per page value (column 8, lines 1-53: "Pages 116...all changes

are reflected in the next invoice generated…multiplied out by the price per print").

(10) Response to Argument

Appellant's arguments filed 10/22/10 have been fully considered but they are not

persuasive.

-With regard to Appellant's remarks on Page 14, Line 19-Page 16, Line 6, the Examiner

acknowledges that said remarks are merely an example of Appellant's claimed invention. It is

noted that the features upon which Appellant relies (i.e. Specification Page 95, line 25 to Page

96, line 22) are not recited in the rejected claim(s). Although the claims are interpreted in light

of the specification, limitations from the specification are not read into the claims. See In re Van

Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Examiner notes that the

independent claims, as argued below, do not provide a specific calculation as exampled in

Appellant's specification.

-In regard to independent claims 1, 9, and 17, Appellant argues that the combination of

the Norris and Ogawa references does not teach or suggest the concept of generating an

estimated price for producing a user defined content object, wherein the estimated price was

calculated based on an estimated content count. Specifically, the Appellant argues that Ogawa

does teach or suggest, "generating an estimated content count for the selected content entities

that represents an estimated quantity of content within the content object, wherein the digital data

within the selected content entities are utilized to determine the estimated content count

representing the estimated quantity of content within the content object, and generating from the

estimated content count the estimated price to serve as the price for the user to produce the user-

defined content object with the selected content entities in response to said parameter setting

indicating the estimated price, wherein the estimated price is determined based on a price per

unit of content, and wherein the unit of content represents a predetermined quantity of content

and the estimated content count indicates an estimated quantity of said units of content for the

selected content entities." The Examiner respectfully disagrees with the Appellant and notes that

the Ogawa reference teaches said features as discussed below.

As noted above in the rejection of the claims, the Ogawa reference teaches a method and

system for calculating the estimated size (column 3, lines 34-39: "calculating sizes of actual

media data and adding up the media data sizes to estimate the total size of an overall application

based on said media dependent attribute") and an estimated cost (column 3, lines 40-46:

"calculation module adds up the actual media creation costs for calculation of an estimate of the

cost of each media type and an overall application") of generating a multimedia application (i.e.

content object)(column 1, lines 12-15: "creating a multimedia application"). Ogawa teaches

wherein the multimedia application could include a plurality of surrogate media objects wherein

the surrogate media objects represented the actual media object to be created later for the

multimedia application and wherein the surrogate media objects included for example, voice

objects, image objects, and moving picture objects (column 3, lines 20-29: "surrogate

media…representing actual moving picture objects, voice objects, or image objects to be created

later"; column 4, lines 12-16: "storing and managing said media objects as surrogate media

objects"). The system of Ogawa taught that surrogate media objects necessary for creating the

multimedia application where then collected in a list which was utilized for calculating the

estimated size/content count and/or cost of each type of media object as well as the total

estimated size/count count and/or cost for the multimedia application. To calculate the estimated

size/content count of the multimedia application, Ogawa taught a calculation module that

calculated the estimated content count/size for each of the media types (Fig. 11: 115, 118,

1111)(i.e. selected content entities) based on media dependent attributes and on the predefined

formulas that factored in the amount of digital data within the surrogate media objects (column 4,

lines 19-27: "user to enter media-dependent attributes, such as size…means for calculating size

of each piece of media data estimating the size of each type of media"; column 11, line 45-

column 12, line 22: "Calculation module…calculates the data size of each object…reads

surrogate media objects, one at a time, from the surrogate media management model…calculates

the size using the following formula…Voice data size =…Still picture data size=…Moving

picture data size=")(Fig. 11). Ogawa further taught that the estimated content count for each

media type was then added together to get a total estimated content count for the multimedia

application (column 4, lines 24-29: "estimating the total size of an application"; column 12, lines

21-38: "application size is calculated as (total voice data size+total still picture size+total moving

picture size"). Wherein the Appellant specifically argues that the estimated size calculation of

Ogawa was not utilized to generate an estimated price based on a per unit price of content, the

Examiner respectfully disagrees. Ogawa specifically teaches wherein the estimated price for

generating the multimedia application was directly related to the size of the collection of

calculated surrogate media objects (column 13, lines 1-55: "cost information list added to the

surrogate media object…size information list…five hours to complete a bit map….cost per hour

is 100 dollars…reads surrogate media objects, one at a time"). For arguments sake, even if the

Ogawa reference was silent in relating the size information and the estimated price, the Examiner

notes that the concept of relating an amount of information/product to be purchased to its cost is

well known in the commerce art (e.g. see above with reference to Norris and Dedrick's cost

determining systems). Wherein Appellant argues that the estimated object size is determined

from default values or values entered by a user for object characteristics and not from being

estimated from the actual digital data within the objects, the Examiner respectfully disagrees.

First, the Examiner notes that as currently claimed the independent claims do not preclude the

specific formulas for calculating the size of the surrogate media objects as taught in Ogawa and

merely require "wherein the digital data within the selected content entities are utilized." Thus

the formulas in Ogawa clearly teach wherein the calculations of sizes include calculating based

on the number of bits of data within the voice, still picture, and movie picture digital objects (i.e.

the digital data within the selected content entities was utilized). The Examiner notes that a bit

of digital data is the basic unit of storage information in computing as it is the amount of

information necessary to store a single binary digit (0 or 1).

Regarding generating an estimated price, Ogawa also teaches an additional calculation

module for generating an estimated cost (column 3, lines 40-46: "calculation module adds up the

actual media creation costs for calculation of an estimate of the cost of each media type and an

overall application"; column 4, lines 40-48: "means for estimating the size of each type of media

data and estimating the total cost of an application") for creating the multimedia application (Fig.

12). Ogawa taught that the estimated price for each media type was generated (Fig. 12: 125,

128, 1211) and then the total of each type was added together to determine a total estimated price

(Fig. 12: 1212) for creating the entire multimedia application (column 12, line 58-column 14,

line 36: "has the advantage of the first embodiment and, in addition to it, allows the users to

estimate costs…cost information list...scheduled development time...cost per hour…calculates

the size…in addition…the development cost of the application…Voice data development

cost=…Still picture media development cost=…Moving picture development cost="). Wherein

the Appellant specifically argues that that the estimated price of Ogawa was not determined

based on a price per unit of content, wherein the unit of content represents a predetermined

quantity of content, the Examiner respectfully disagrees. Ogawa clearly teaches that when

calculating the estimated price for a surrogate media object (e.g. voice, still picture, or moving

picture) the price was determined based on a price per unit of content as set by the user (column

13, lines 3-39: "allow the user to enter the cost information items"). In the given example,

Ogawa teaches that based on the media type and size of a given media object, a user can assign a

development time in hours and a cost per hour for said media object. Ogawa teaches that for a

unit of bit map image content the estimated processing cost was assigned at 100 dollars per hour

(column 13, lines 35-44; column 22-37: "sets a fixed value for the cost per hour…allow the user

to enter a cost for…use in calculation"). As noted above, the claims lack a clear distinction on

specifically how the total estimated price for the user defined content object is "generated" from

the estimated content count in that the various elements of the estimated price are only based on,

represent, and/or indicate other claimed elements.

-While not relied upon in the above rejection, the Appellant has argued that the Dedrick

reference does not teach calculating an estimated price based on a price per unit of content,

wherein the unit of content represents a predetermined quantity of content and the estimated

content count indicates an estimated quantity of units of content for the selected content entities.

The Examiner respectfully disagrees and notes that Dedrick clearly teaches wherein a unit of

electronic information generated by a publisher to be viewed/consumed by a user can include

video, audio, graphics, animation, and text (column 4, line 45-51). Here the unit of electronic

information is equivalent to the content object and the individual types of information comprise

the content entities. Dedrick specifically teaches calculating an estimated price based on a price

per unit of content wherein the content within the content entities is measured in a predetermined

quantity of bytes (column 3, lines 60-63: "will calculate the price of the requested information";

column 4, line 54-column 5, lines 25: "cost type and cost value can be utilized to calculate a

price…to payment on a per byte…pay per byte…"$0.10 per Mbyte"). Dedrick teaches wherein

the unit of content represents a predetermined quantity of content (i.e. a "byte" of information) and the estimated content count indicates an estimated quantity of units of content for the desired/requested content entities (column 7, lines 29-33: i.e. with a pay per byte cost type selected the calculated price equals sum of all the bytes making up all the different types of information (text, audio, video, animation, graphics) in the requested electronic information unit).

-In view of independent claims 1, 9, and 17, the Examiner would like to additionally point out that the claim language does not specifically require the generation of both an estimated price and an actual price. Either an estimated price or an actual price is generated for the content object based on a parameter setting, wherein the parameter setting is not further defined. As discussed above and shown in the rejection, the Examiner believes that Norris in view of Ogawa clearly teach the ability to create both an actual price and an estimated price for producing a content object comprised of a plurality of content entities. The references have been provided to show that the calculating of an actual price and an estimated price for an electronic content object were notoriously well known in the art at the time of the invention. However the claim language of the independent claims generates a price for said content object in the alternative form (i.e. the claims do not require generating both an actual price and an estimated price and then selecting between the two, but rather require only generating one or the other based on some parameter setting). The Appellant's arguments appear to support such an interpretation (Argument: Page 15: "Optionally, actual costs may be utilized to produce the book's cost"). So at the very least, the Norris reference specifically teaches creating an actual price for the content entity (column 5, lines 16-22: "price database...prices for various sized

pictures and various mats"; column 6, lines 12-22: "calculate a customer invoice...picture sizes selected...their selected page locations"; column 8, lines 35-40: "the number of each size print is counted and then multiplied out by the price per unit"; column 9, lines 10-14; column 10, lines 4-17: "price is generally determined by the number and size of the selected images"). The Examiner notes that the subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Adam L Basehoar/

Primary Examiner, Art Unit 2178

12/29/10

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